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EXAMINER

CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/489,171

Applicant(s)

DOLJACK, FRANK A.

Examiner

Paul Callahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-67 and 77-107 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 53-60, 87, 94-96, 100 and 101 is/are allowed.
- 6) ☐ Claim(s) 44-52, 61, 63, 65-67, 77-86, 88-93, 97-99 and 102-107 is/are rejected.
- 7) ☒ Claim(s) 62 and 64 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 44-67 and 77-107 are pending and have been examined.

Response to Arguments

2. Applicant's arguments filed 11-21-05 have been fully considered but they are not persuasive.

The applicant argues in traverse of the rejections of claims 97 and 98 by asserting that Gilham '846 fails to teach the feature of "determining whether an encrypted code is present". Yet a further review of the reference shows that Gilham does teach such a feature at, for example fig. 2 where the step of reading and verifying an encrypted code is taught. In the absence of an encrypted code the verification step fails, and therefore constitutes a determination of the presence of an encrypted code in addition to verification of the code.

The applicant argues in traverse of the rejections of claims 44-52, 6-67, and 99 by asserting that the claimed feature of "encrypting a combination code" The applicant argues that Gilham does not teach an encrypted combination code that comprises a random and a non random portion. However a further review of the reference shows a combination code formed in fig. 2 by the assembly of a "data block" composed of a random number and non-random values. This "data block" or "combination code" is then encrypted.

The Applicant argues in traverse of the rejection of claims 49 and 51 that Gilham fails to teach determination of whether the decrypted combination code contains the

non-random portion of the combination code and comparison of the decrypted non-random portion to that found in the combination code. Yet a review of the reference shows that such are taught at fig. 3 and col. 5 lines 25-40 where the non-random portion of the code is evaluated after decryption by the comparison step.

The Applicant argues that Gilham may be distinguished from the instant invention because the reference teaches evaluation of the entire combination code and not just the non-random portion. Yet since Gilham does indeed evaluate the non-random portion, the limitation is taught. That fact that Gilham may evaluate additional information does not distinguish the fact that the non-random portion is indeed evaluated.

The Applicant argues in traverse of the rejections of the claims by asserting that Venkatesan "093 fails to teach a combination code where the non-random portion contains a secret portion that is encrypted. However a review of the reference shows that such is indeed taught at col. 15 lines 5-15.

The Applicant points out that in the Office Action, claims 104-107 were mistakenly indicated as being objected to in addition to being rejected. The claims were only intended to be rejected, as indicated on page 12 of the Office Action.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 of US Patent No. 6,442,276 contains every element of claims 44 of the instant application and as such anticipates claims 44 of the instant application.

“A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus).” *ELI LILLY AND COMPANY v BARR LABORATORIES, INC.*, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 102(b)

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 97 and 98 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gilham US 4,934,846.

Gilham teaches a method of verifying authenticity or other information of goods or the like using an encrypted code (abstract), comprising determining whether an encrypted code is present, determining whether the code when decrypted matches a prescribed code (fig. 2, col. 2 lines 8-29), and determining whether the matched prescribed code is a duplicate and if a duplicate, indicating that at least one or the other of the goods is a duplicate (col. 4 lines 4-10, Pseudo-random numbers selected in sequence, fig. 2 "Fault").

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 44-52, 65-67, 99, 106, and 107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Storch et al., US 5,367,148, and Gilham.

As for claims 44, 47, and 97, Storch teaches a method for verifying the authenticity of goods (abstract), comprising the steps of generating one or more combination codes wherein each has a random portion and a non-random portion (col. 4 lines 37-42), associating the combination codes with one or more goods (col. 4 lines 44-50), wherein each of the goods has a unique combination code (col. 4 lines 44-50); and examining goods to verify whether they are authentic (col. 5 lines 18-28), wherein examining the goods comprises: reading the code associated with one of the one or more goods (col. 5 lines 20-30); and evaluating the code to verify whether the good is authentic (col. 5 lines 20-30).

Storch does not teach encrypting the combination code, or a step for verifying the authenticity of the goods by reading an encrypted combination code, decrypting it, and comparing it to a stored version of the combination code. However Gilham does teach these steps (abstract, fig. 3) therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated this step into the method of Storch. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

As for claim 45, Storch teaches the step of generating one or more combination codes wherein the step comprises the steps of: generating one or more random codes; and combining the one or more random codes with a non-random code (abstract).

As for claim 46, Storch teaches a step of combining wherein combining the one or more random codes with a non-random code is selected from the group consisting of concatenating the non-random code to an end of the random code, concatenating the non-random code to a beginning of the random code and interposing the non-random code within the random code (abstract, col. 4 lines 37-44).

As for claim 48, Storch teaches a step of reading the code that comprises scanning the code (col. 4 line 35).

As for claim 49, Storch does not teach a step wherein the evaluating of the decrypted code comprises determining whether the decrypted code contains the non-random portion of the combination codes. Gilham does teach evaluation of the non-random portion of a combined code after decryption (fig. 3, col. 5 lines 25-40). Therefore it would have been obvious to one of ordinary skill in the art to incorporate this step into the method of Storch. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

As for claim 50, Storch does not teach a step of determining whether the decrypted code contains the non-random portion that comprises visually inspecting the decrypted code. However Gilham does teach this (col. 5 line 48). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to

incorporate this feature into the system of Storch. Motive to make this combination is found for example at col. 2 line 25 of Storch where the reliance on mechanical means is discussed.

As for claim 51, Storch does not teach a method wherein the step of evaluating the decrypted code comprises comparing the decrypted code to the non-random portion of the combination codes. Gilham does teach evaluation of the non-random portion of a combined code after decryption (fig. 3, col. 5 lines 25-40). Therefore it would have been obvious to one of ordinary skill in the art to incorporate this step into the method of Storch. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

As for claim 52, Storch teaches a method comprising the step of determining whether the combination code has been previously used if the random portion matches a portion of the code (col. 4 line 29). Storch does not teach encryption and decryption of the combined code. Gilham does teach evaluation of the combined code after decryption (fig. 3, col. 5 lines 25-40). Therefore it would have been obvious to one of ordinary skill in the art to incorporate this step into the method of Storch. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

As for claim 65, Storch teaches a method step wherein associating the encrypted combination codes with one or more goods comprises applying the encrypted combination codes to the one or more goods (col. 4 line 44-54).

As for claim 66, Storch teaches a method step wherein examining the goods comprises: determining whether the code matches a prescribed code (col. 4 lines 25-35); and indicating whether the matched prescribed code is a duplicate based on the determination (col. 4 line 25-35). Storch does not teach encryption and decryption of the combined code. Gilham does teach evaluation of the combined code after decryption (fig. 3, col. 5 lines 25-40). Therefore it would have been obvious to one of ordinary skill in the art to incorporate this step into the method of Storch. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

As for claim 67, Storch teaches a method step wherein examining the goods comprises: determining whether the code a prescribed code (col. 4 lines 25-35); and indicating that a counterfeit has been detected if the prescribed code is a duplicate (col. 4 lines 25-35). Storch does not teach encryption and decryption of the combined code. Gilham does teach evaluation of the combined code after decryption (fig. 3, col. 5 lines 25-40). Therefore it would have been obvious to one of ordinary skill in the art to incorporate this step into the method of Storch. Motivation to make this combination is

found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

As for claim 99, Storch teaches a method of coded labeling of goods, process or the like (abstract), comprising obtaining a random number, alphanumeric or the like code and a further non-random string, alphanumeric, or the like code; coupling the codes to obtain a combination code with a random portion and a non-random, label portion (col. 4 lines 37-44); applying or associating the combination code to or associating it with goods, process or the like (col. 4 lines 44-50); and verifying authenticity of the goods, process or the like or of some characteristic thereof by determining whether the non-random label portion is found and/or is correct (col. 5 lines 18-28). Storch does not teach encrypting the combination code, and decrypting it prior to verification. Gilham however, does teach these steps (abstract, fig. 3, col. 2 lines 20-30). Therefore it would have been obvious to one of ordinary skill in the art to incorporate this step into the method of Storch. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

9. Claims 61, 63, 77-86, 88-93, and 102-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Storch and Gilham, and further in view of Venkatesan et al., US 6,209,093.

As for claims 77 and 84, Storch teaches a method of identifying items, comprising associating with respective items respective combination codes or indicia, each composed of a unique random portion and a non-random portion (abstract), Storch fails to teach an encrypted combination code. However Gilham does teach this step (abstract, fig. 3). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the method of Storch. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm. The combination of Storch and Gilham fails to teach a step wherein the nonrandom portion includes at least a secret portion that is encrypted. However Venkatesan does teach this feature (fig. 1 item 87). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the system of Storch and Gilham. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm

As for claims 78, 85, and 91, the combination of Storch and Gilham fails to teach a step where the secret portion is encrypted with a public key and can be decrypted with a corresponding private key. However Venkatesan does teach this feature (abstract) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the system of Storch and Gilham. Motivation to

make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

As for claims 79, 86, and 92, the combination of Storch and Gilham does not teach a step wherein the non-random portion of the combination code includes a secret encrypted portion containing tracking information. However Venkatesan does teach this feature (col. 4 lines 47-54: Indicia printed on product). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the system of Storch and Gilham. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

As for claims 80, 88, and 93, Storch fails to teach a step comprising decrypting the combination code; However Gilham does teach evaluation of the a combined code after decryption (fig. 3, col. 5 lines 25-40). Therefore it would have been obvious to one of ordinary skill in the art to incorporate this step into the method of Storch. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm. The combination of Storch and Gilham fails to teach decrypting the secret portion of the decrypted combination code to determine the tracking information or information about the product. However Venkatesan does teach this step at (col. 13 line 65, col. 14 line 5) Therefore it would have been obvious to one of ordinary skill in the art at the time of the

invention to have incorporated this step into the system of Storch and Gilham.

Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

As for claims 81-83, Storch teaches a step of associating comprising applying the respective combination codes in the form of bar codes or alphanumeric symbols to respective items or labels associated with the items (fig. 2)

As for claim 89, Storch teaches selecting the non-random portion as at least one of a readable word, number or alphanumeric (col. 4 lines 37-44).

As for claims 61, 63, 90, 102, and 103, Storch teaches a method of checking authentication of an item identified by a combination code, each combination code including a unique random portion and a non-random portion (col. 4 lines 37-44). Storch does not teach that the nonrandom portion includes at least a secret portion containing tracking information that is encrypted. However Venkatesan does teach this step (fig. 1 item 87). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the system of Storch. Motivation to make this combination is found for example, (col. 16 lines 5-8), where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm. The combination of Storch and Venkatesan does not teach an encrypted combination code

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or checking the decrypted combination code to determine whether the non-random portion is correct or obtain tracking information. However Gilham does teach this step (fig. 4: "Decrypt and Check Validation"). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the system of Storch and Venkatesan. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm

As for claims 104-107, the claims represent the computer program product embodied in a memory medium that causes a computer to carry out the method of claims 77 and 97 when executed. Therefore claims 104-107 are rejected on the same basis as claims 77 and 97.

Allowable Subject Matter

10. Claims 53-60, 87, 94-96, 100 and 101 are allowed.

11. Claims 62 and 64 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

2-2-06

Paul Callahan

E. Moise
EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER